

REMARKS

Claims 1-71 are pending in the application. Claims 10-11, 20, 22, 25-51 and 53-71 have been canceled without prejudice. Claims 1, 12 and 52 remain as independent claims. Claims 1, 4, 6, 7, 8, 12, 14, 16, 17, 21, 23 and 52 have been amended. Claims 72-74 are new. No new matter has been added by these amendments. It is believed that the remarks presented herein below address each of the Examiner's rejections of the claims.

Claim Rejection – 35 U.S.C. §102

Claims 1-9, 12-19, 21, 23-24

Claims 1-9, 12-19, 21, 23-24 and 52 are rejected under 35 U.S.C. §102(e) on the basis of being anticipated by US Patent 7,111,230 to Euchner et al, hereinafter "Euchner." Applicant respectfully disagrees and traverses this rejection.

With respect to Examiner's §102 rejection, respectfully, to anticipate a claim, Euchner must teach each and every element of the claim, and **"the identical invention must be shown in as complete detail as contained in the ... claim."** MPEP 2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987) and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989) (emphasis added).

Examiner's attention is first directed to the recitation of Prior Art in the present application wherein it is discussed that although there is a desire to use one printer to print both the human discernible content and the Anoto-type digital pattern at the same time, this desire has inherent disadvantage.

"That realization is a factor in making the present invention. That realization is that if the pattern and text (content) are printed simultaneously on the same printer each user who desires to print out a document having a digital pattern needs access to a high-resolution printer capable of printing the position determining pattern to a resolution good enough to allow pen strokes to be captured. This is beyond the capability of many existing printers (e.g. 150 dpi may not be good enough). **This means that hundreds of millions of legacy printers cannot be used with such a system.** Such a system would also place a high computational and memory burden on the printer and instructing PC. High-resolution printers that have sufficient resolution to print out the Anoto digital pattern are also often expensive." See Para 16, emphasis added.

Euchner clearly and unambiguously teaches repeatedly that the same printer is used. "In an illustrative embodiment, **a special printer is used to print both the digital paper and the**

document so that the electronic master document is associated with the printed hardcopy.” Col. 4 lines 38-41, emphasis added. This special printer is clearly not a legacy printer and as such Euchner offers no advantage cost savings for an existing system having existing legacy printers. Moreover, any advantageous cost savings between toner and ink as used by a first and second printer or the advantageous cost savings through the reuse of existing legacy printers is simply not permitted under Euchner.

Independent claims 1, 12 and 52 have been amended to further clarify the pattern as being provided by a first printer and the content as being provided by a second printer.

The associated dependent claims inherit the clarified status of a first and second printer and are therefore also distinct over Euchner. Respectfully, Examiner is in error citing to Col. 9 lines 19-25 in support of Euchner teaching the code being read by the second printer – claim 2. More specifically Euchner teaches that a digital paper scanner may be used but does not teach that the scanner is indeed a part of the second printer (no second printer being taught to begin with). At best Euchner teaches the paper code is read by the scanner, but it is an unfounded leap to assert that the paper code is read by the second printer.

Further the machine readable identity code provided by the second printer is set forth in the present application as being selected from a pattern of dots, a pattern of lines, a pattern of printed objects, a position determining pattern and a bar code – see claim 5. Euchner does not teach that an identity code such as this. Column 2 lines 34-36 teach editing symbols which are different.

Euchner clearly fails to teach each and every element of the claim as **“the identical invention must be shown in as complete detail as contained in the ... claim.”** *Id.* Though other differences exist as well, the lack of a clearly specified first printer to provide the digital pattern and the second printer to provide the content is such that Euchner can not be said to anticipate Applicant’s invention as set for in claims 1-9, 12-19, 21, 23-24 and 52. Withdrawal and allowance of claims 1-9, 12-19, 21, 23-24 and 52 is therefore requested.

Claim Rejection – 35 U.S.C. §103

Claims 21 and 23-24

The Examiner has rejected claims 21 under 35 U.S.C. §103(a), as being unpatentable over Euchner in view of US Patent 6,915,281 to Coffy et al., 6,915,281, hereinafter “Coffy.” Applicant respectfully disagrees with and traverses these rejections.

The Examiner has rejected claims 23-24 under 35 U.S.C. §103(a), as being unpatentable over Euchner itself alone. Applicant respectfully disagrees with and traverses these rejections.

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007):

“Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” Quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966).

As set forth in MPEP §2143.03, to ascertain the differences between the prior art and the claims at issue, “[a]ll claim limitations must be considered” because “all words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385. According to the Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of *KSR International Co. v. Teleflex Inc.*, Federal Register, Vol. 72, No. 195, 57526, 57529 (October 10, 2007), once the aforementioned *Graham* factual inquiries are resolved, there must be a determination of whether the claimed invention would have been obvious to one of ordinary skill in the art based on any one of the following proper rationales:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

- (E) "Obvious to try"—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. *KSR International Co. v. Teleflex Inc.*, 550 U.S. __, 82 USPQ2d 1385 (2007).

In accordance with the above provisions, a review of the cited references Euchner and Coffy is therefore in order.

Euchner, as its title suggests, clearly teaches a system and method for annotating documents. Euchner provides multiple examples and description for how various people are provided with copies of a master document and each person's edits to the master document are then tracked and recorded. As is discussed above, and incorporated herein by reference, Euchner does not teach the digital pattern being provided by a first printer and the content being provided by a second printer. Examiner appears to acknowledge this on page 15 of the office action, and provides Coffy to combine and cure this deficiency.

Coffy quite clearly teaches a system and method for using a digital pen for funds accounting devices and postage meters. Coffy teaches that the envelope has pre-printed embedded intelligence that can be read by the pen. Col 5, lines 1-10. Coffy further teaches that the pen is used by a user to write upon the envelope so as to indicate an address, class of postage and amount of intended postage. Coffy does not teach a second printer. The pen is described as having a processor and components enabling it to detect position and/or BIODATA – as a pen any and all ability to provide a mark is achieved by a human operator manipulating the pen in the exercise of drawing or writing. This pen as taught by Coffy is not equivalent to the second printer as set forth in the present application, and Examiner is in error to do so. To remove the pen and substitute a printer would clearly frustrate the purpose and teaching of Coffy as the human user would not be able to use a second printer in the same manner as a pen.

In light of the above summary of Euchner and Coffy it is respectfully submitted that the Examiner has failed to resolve the *Graham* factual inquiries by failing to properly ascertain the actual differences between the prior art references of Euchner and Coffy and at the very least claim

1, 12 and 52 which now each incorporate the clear distinction of a first and second printer as originally present in claim 20.

Although other differences certainly exist, these are critical to the teachings of Euchner and Coffy and cannot be ignored. Indeed a large number of devices may exist in the prior art where, if the prior art is disregarded as to its content, purpose, mode of operation and general context, the several elements claimed by the Applicant, if taken individually, may be disclosed. However, the important thing to recognize is that the reason for combining these elements in any way to meet Applicant's claims only becomes obvious, if at all, when considered from hindsight in the light of the application disclosure. The Federal Circuit has stressed that the "decisionmaker must step backward in time and into the shoes worn by a person having ordinary skill in the art when the invention was unknown and just before it was made." *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1566 (Fed. Cir. 1987). Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s). Respectfully, the March 26, 2008 Office Action has failed to meet this burden.

The guidelines under KSR echo this point, and evidence how and why Examiner's view of obviousness from the combination of references is unfounded.

For a combination of references to be proper there must be:

1 - a finding that the prior art included each element claimed with the only difference between the claimed invention and the prior art being the lack of actual combination.

This is not done – The claims of the present application clearly assert that there are two printers – one providing the pattern and a second providing content and in certain embodiments an identity code. Euchner does not teach two printers and Coffy does not teach two printer. Moreover, all of the claimed elements are not shown and the only difference is clearly not the lack of actual combination.

2 – a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely would have performed the same function as it did separately.

This is not so – Euchner and Coffy fail to provide all of the elements as presented by Applicant. Spontaneous acquisition of missing elements is certainly not disclosed, and known methods as applied to the Euchner and Coffy disclosed elements will not provide them.

3 – a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable.

This is not so - The modifications required to Euchner and Coffy are so significant and contrary to the teachings, that the results are in no way predictable.

4 – any additional findings.

Respectfully, as the Examiner has mischaracterized the references and the associated differences with the present invention. Examiner's statement of "official notice" that the printer doing the printing of the pattern would have better resolution than the second printer is unfounded. There is simply no sustainable inference for a second printer let alone that the second printer would have lesser, greater or equal printing resolution. Only in the present application is the issue of the second printer specifically realized and that the second printer may have lesser resolution – e.g., a legacy or existing printer already in the workplace environment that would have to be replaced for the specialized printer as taught by Euchner.

Respectfully, "***If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims prima facie obvious.***" *In re Ratti* 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (comment added). Euchner specifically teaches a special printer providing both the pattern and the content. Coffy clearly teaches the pattern to be provided by a printer and then the pen to be used by a human operator to provide additional information and the pen is not and can not be interchanged with the second printer as set forth in the present application.

Without some reason in the references to combine the cited prior art teachings, with some rational underpinnings for such a reason, the Examiner's conclusory statements in support of the alleged combination fail to establish a prima facie case for obviousness. See, *KSR International Co. v. Teleflex Inc.*, No. 04-1350, 550 U.S. ____ (2007) (obviousness determination requires looking at "whether there was an apparent reason to combine the known elements in the fashion claimed...", citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness," *KSR* at 14).

As the *Graham* factual inquire is not properly resolved, application of any of the rationales (A)-(G) as set forth in the guidelines is futile for Euchner and Coffy fail to provide all of the claim elements as set forth in claims 1, 12 and 52, let alone these claims with their respective dependent claims.

More specifically, because the Examiner has failed to ascertain the actual differences between Euchner and Coffy and the presently described and claimed invention, Examiner's conclusion that Euchner and Coffy make obvious all of the features as recited in these claims is in error. Though Examiner's original 103 rejections were limited to claims 20, 21, 23 and 24, the present amendments as discussed above suggest the issues above as relevant to remaining claims 21, 23 and 24 are also applicable to all of the presently remaining claims.

Respectfully, withdrawal and allowance of claims 1-9, 12-19, 21, 23-24 and 52 is requested.

New Claims

As is set forth in the present application, e.g., paragraphs 16 and 68 for example, the present method is applicable in an environment having existing legacy printers. The present method therefore advantageously minimizes additional costs and expense when implemented by utilizing existing equipment. Claims 72, 73 and 74 are new claims that incorporate this aspect. As discussed above, Euchner and Coffy do not teach first and second printer and more specifically do not teach the use of existing legacy printers. Allowance of claims 72-74 is therefore respectfully requested.

Conclusion


In view of the above Remarks and the amendment to the claims, Applicant has addressed all issues raised in the Office Action dated July 14, 2008, and respectfully solicits a Notice of Allowance for claims 1-9, 12-19, 21, 23-24, 52 and 72-74. Should any issues remain, the Examiner is encouraged to telephone the undersigned attorney.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of

that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

As three claims were canceled and three claims were added, Applicant believes that no fees are currently due; however, should any fee be deemed necessary in connection with this Amendment and Response, the Commissioner is authorized to charge deposit account 08-2025, referencing the Attorney docket number 200208339-1.

Respectfully submitted,

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